

REMARKS

Upon entry of the Amendment above, claims 8-24, 26-27, 64, 68-71, and 76-78 will be pending in this application. By this Amendment, claims 8 and 70 have been amended, claims 66 has been cancelled, and new claim 78 has been added.

In addition to certain claim amendments made for the purpose of clarify, certain claims have amended or new claims have been added to recite one or more of the following (examples of areas of the specification that provide support for the amendment are listed in parentheses):

1. 0.5 to 30 weight percent of a high Tg component (paragraph 51 pf published application);
2. reactive diluent comprises 0.5 to 25 weight percent of multifunctional radiation curable moieties (paragraph 50 of the published application); and
3. elongation of at least 50% in a cured state (paragraph 31 of the published application)

No new matter has been added as a result of the amendment to the claims.

§ 103 Rejection of the Claims

Claims 8-24, 26, 27, 64-66 and 68-71 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over WO 98/27171. Applicants traverse the rejection to the extent that it is maintained.

As described in the present specification, selection of components having such functional characteristics result in durable, weather-resistant, ink jettable compositions. The specification further states that cured compositions with elongation characteristics over 50% are desirable, and such a limitation is now in the present claims. If the reactive diluent has too high an overall functionality, the elongation characteristics will be diminished. Accordingly, the present claims now recite that the reactive diluent comprises 0.5 to 25 weight percent of multifunctional radiation curable moieties. The inclusion of each component in the claimed compositions serves a purpose towards achieving the desired properties enumerated above. The present claims discuss a multitude of characteristics of monomers of the reactive diluent that are effective at achieving the desired properties.

WO 98/27171 generally and briefly discusses monomers that may be employed at page 6, line 12 – page 7, line 2. No guidance is provided as to how one may employ the monomers recited to achieve the properties recited by the present claims.

The Office Action appears to state it would have been obvious to arrive at the monomers as recited in the claims because the Examples of WO 98/27171 employ combinations of monomers (stating specifically that “WO ‘171 provides motivation by using combinations of monomers in the claims”). However, the Examples like the specification appear to be devoid of any teaching that would suggest that employing monomers as recited in the present claims would be desirable, particularly with regard to the elongation properties now recited in the present claims.

A fair reading of WO 98/27171, in the absence of hindsight, leads to the conclusion that one would not have been lead to arrive at compositions of claims 8-24, 26-27, 64-66 and 68-71 of the present application based on the teachings of WO 98/27171. Accordingly, claims 8-24, 26, 27, 64-66 and 68-71 are not obvious in light of WO 99/29787.

Withdrawal of the rejection is respectfully requested.

Obviousness-Type Double Patenting

Claims 8-24, 26, 27, 64-71 and 76-77 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-18 of US Patent No. 6,534,128 and claims 1-6 of US Patent No. 6,558,753. Applicants defer response to this rejection given the amendments to the claims.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of the merits of the application.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 13-3723.

Respectfully submitted,

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Date

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